

REMARKS

Applicant appreciates the Examiner's review of the above-identified patent application and respectfully requests reconsideration and allowance in view of the above amendments and following remarks. Applicant also appreciates the Examiner granting a telephone interview with Applicant's Representative, Paul J. Kroon, Jr., Esq., on August 9, 2005. With this amendment, claims 1, 2, and 14 have been amended.

Claims 2 and 14 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. Despite numerous attempts to clarify this rejection with the Examiner, Applicant is still entirely unclear why this particular language is indefinite.

In the Office Action dated January 20, 2004, the Examiner states, in relevant part, "the phrase 'generally opposite' does not definitely recite the structural relationship between the parting agent covered surface area, the substrate and the clean surface area" and that this amounts to being incomplete for omitting essential structural cooperative relationships of elements.

In the present Office Action, the Examiner then refers to MPEP § 2172.01 (Unclaimed Essential Matter). MPEP § 2172.01 states, "a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected". MPEP 2173.01 further states that essential matter is that which is "disclosed to be essential to the invention as described in the specification or in other statements of record."

The Examiner has failed to provide any support for the proposition that the matter in question is "essential". Applicant submits that while the language used may be broadly interpreted, it is not indefinite. Again, Applicant directs the Examiner's attention to MPEP § 2173.02 (Clarity and Precision) that states, in relevant part, "The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available." Nevertheless, Applicant has cancelled the language in question in an attempt to remove any perceived indefiniteness.

Claim 14 has been rejected as lacking antecedent basis. In particular, the Examiner states that "said granular materials"

lacks antecedent basis. Applicant assumes that this rejection is the same as the Examiner's rejection of the previously recited "said adjacent rolled roofing membranes". For reasons unclear to Applicant, the Examiner withdrew this rejection by replacing the word "said" with "the". For this reason, Applicant has amended "said granular materials" to read "the granular materials".

Applicant submits that the antecedent basis requirement does not require the explicit and exact recitation of the term in question. Applicant requests that the Examiner review MPEP § 2173.05(e) (Lack of Antecedent Basis) which recites, in relevant part, "the failure to provide **explicit** antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be **reasonably** ascertained by those skilled in the art, then the claim is not indefinite. *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("controlled stream of fluid" provided reasonable antecedent basis for "the controlled fluid")." Applicant submits the one skilled in the art would have certainly been able to ascertain the scope of the claim.

Claims 1 and 14 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner states that the language, "said lower surface adapted to

disposed proximate said support surface when covering said support surface" is indefinite because "the structure intended to be recited by the term 'proximate' cannot be ascertained".

With this amendment, Applicant has amended claims 1 and 14 to supply the obviously missing word "be" between "to" and "disposed". Applicant submits that the term "proximate" as used in claims 1 and 14 is not intended to define "structure" as suggested by the Examiner. The phrase in question specifies the orientation of the upper and lower surfaces of the substrate vis-à-vis the support to which it is applied. More specifically, the entire phrase in question recites, generally, that the lower surface of the substrate is disposed near support when the rolled covering material is covering (applied to) the support. By specifying the orientation of the upper and lower surfaces of the substrate, the orientation of the decorative surface area, clean surface area, granules, adhesive surface area, and release backing are also defined vis-à-vis the support to which they are applied making the claim more definite, not indefinite. While this language is broad (i.e., it leaves open the possibility of other elements being disposed between the rolled covering material and the support such as, but not limited to, an underlayment,

insulation, or the like), it clearly meets the definiteness requirement recited in MPEP § 2173.02 and discussed above.

For at least these reasons, Applicant submits that this rejection is improper. Should the Examiner repeat this rejection, clarification of the Examiner's position is requested. If the rejection was based on the obviously missing word "be", further explanation/specificity of the Examiner's rejections in the future is requested.

Claims 1-9 and 11-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennepohl et al. (hereinafter referred to as "Kennepohl") in view of Simpson et al. (hereinafter referred to as "Simpson") and in further view of McGroarty et al. (hereinafter referred to as "McGroarty"). Applicant respectfully traverses this rejection.

As discussed in the previous response, Applicant submits that McGroarty does not disclose or suggest "an asphalt composition saturating said substrate and coating a portion of said upper surface of said substrate to form a decorative surface area and a clean surface area on said upper surface of said substrate" as recited in independent claims 1 and 14.

The Examiner acknowledges that neither Kennepohl nor Simpson

disclose or suggest these limitations. During the telephone interview with Applicant's Representative on August 9, 2005, the Examiner appeared to acknowledge that item 13 of McGroarty is disposed on the bottom surface of the waterproofing sheet 10. Applicant directs the Examiner's attention to the previous response dated December 3, 2004 for proof of this proposition. During said telephone interview, the Examiner then stated that his position is that he believes there is no patentably distinction between the upper surface of the substrate as claimed in the present invention and the lower surface of McGroarty and that it is merely a "design choice" and is "well known". Applicant respectfully traverses this assertion.

To the extent that it is the Examiner's position that having a clean surface area and a decorative surface area disposed on the upper surface of the substrate with an adhesive surface area disposed on the bottom is "well known" in the prior art, Applicant respectfully traverses this assertion under MPEP § 2144.03.

In rejecting the claims, the Examiner states in the present Office Action,

McGroarty teach[es] that the "lap" structure of one sheet "lapping" another sheet over the clean surface area of the another [sic] sheet is a well known structure in the art of

roof waterproofing, one of ordinary skill in the art would have recognized to have set the particular orientation of the edge portion 13 depending on the particular desired end result. (Paragraph 6 of the present Office Action) (Emphasis added.)

In the prior Office Action dated July 29, 2004, the Examiner stated that the desired end result of the modification to Kennepohl is to "provide a continuous impervious layer as taught by McGroarty et al." (Emphasis added.) Applicant submits that this conclusion is improper and does not provide any support for the proposed modification since the roofing material disclosed by Kennepohl already provides "a continuous impervious layer" as taught by Kennepohl.

One of the problems with the prior art rolled roofing products is discussed in paragraph [0004] of the BACKGROUND OF THE INVENTION section of the present application, which states, in relevant part,

Rolled roofing products have an adhesive between the overlap formed between succeeding strips of the roofing material forming a water-proof seal. The adhesive also prevents wind from uplifting and separating the roofing material. Typically, rolled roofing products are either entirely coated with roofing granules on the top surface or only the exposed portion of the top surface is coated with roofing granules. In the first case, the roofing granules in the overlap area prevent strong adhesion between overlapping layers making the product susceptible to separation in high winds. In the second case, a parting agent is required to prevent the

asphalt from sticking in the rolls. The parting agent interferes with adhesion between layers, however, making the product susceptible to separation in high winds.

The present invention addresses this problem as discussed in paragraph [0021] of the DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT section of the present application,

Because of the low adhesive nature of the oxidized, filled asphalt composition saturating the substrate 12 and because the clean surface area 20 is substantially scraped down to the fibrous material, the clean surface area 20 is substantially free of parting agent when unrolled. As a result, the adhesive material 36 adheres better to the clean surface area 20 in use.

Applicant submits that the reason McGroarty includes edge portion (item 13) is to protect the bentonite layer 11 from exposure to water. If the bentonite layer 11 was extended to the edge portion (item 13), the bentonite layer 11 would be exposed to water causing the bentonite layer 11 to undesirably expand. Kennepohl and/or Simpson do not disclose a bentonite layer, nor anything resembling or providing the same function, and McGroarty does not disclose (or even suggest) coating the top surface of the polymer membrane 10 with an asphalt composition. Accordingly, when read as a whole there is NOTHING in McGroarty (nor any of the other references cited) that discloses a clean surface area and a decorative surface area disposed on the top surface of an asphalt

saturated substrate. Consequently, there is nothing in any of the references that would lead one skilled in the art to modify Kennepohl to include a clean surface area on the TOP surface of the substrate as recited in independent claims 1 and 14 to increase the adherence between adjacent rolled roofing materials.

Moreover, Applicant further submits that McGroarty teaches away from the present invention and the proposed modifications suggested by the Examiner. It is axiomatic that all the references must be read as a whole. As discussed above, McGroarty specifically teaches having the edge portion (item 13) arrange on the bottom surface (and not on the top surface as claimed in the present invention) specifically to avoid exposing the bentonite layer 11 to water, and therefore teaches away from having the bentonite layer 11 (and consequently the combination of a clean surface area and a decorative surface area) on the top surface. Whereas the present invention solves the problem of adhering of adjacent rolled roofing materials, the edge region (item 13) of McGroarty further teaches away from the present invention by actually making the adhering of adjacent waterproofing sheets 12 more difficult. McGroarty discloses that adhering polymeric layers (item 10) has been difficult (resulting in polymeric

materials not being used as above grade roofing or below grade waterproofing products) and purports to have solved this problem by adding the bentonite layer 11. Specifically, column 3, lines 6-30 of McGroarty discloses

Many polymeric materials which are currently not in use as above grade roofing or below grade waterproofing products because of the great difficulty in causing them to adhere to the building wall or substrate can now be used because the bentonite layer when wet holds the membrane in place ... Polymers such as [] can be used for the membranes in the present device.

Despite the purported adhering benefits of the bentonite layer 11, McGroarty teaches away from the proposed medication by specifically disclosing leaving the bottom edge portion (item 13) free from the bentonite layer 11, thereby making adhesion more difficult. Again, as discussed above the reason for this is to protect the bentonite layer 11 from exposure to water.

Accordingly, Applicant submits that the combination of the references cited by the Examiner does not disclose or suggest all the limitations of the independent claims. To the extent that the Examiner is relying on the clean surface area and the decorative surface both being disposed on the top surface of the substrate as being "well known" in the prior art or merely a "design choice", Applicant respectfully traverses this assertion under MPEP §

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2144.03 and requests that the Examiner provide proof of this assertion.

Applicant submits that the present amendment does not require further consideration and/or search and clearly places the claims into condition for allowance. Applicant requests entry of the amendment under 37 C.F.R. § 1.116.

The examiner is invited to telephone the undersigned, applicant's attorney of record, to facilitate advancement of the present application.

Respectfully submitted,

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